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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,615	01/30/2004	Hidehiko Ogawa	P24497	5644
7055	7590	11/29/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			LEE, TOMMY D	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/767,615	Applicant(s) OGAWA, HIDEHIKO	
	Examiner Thomas D. Lee	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15 and 29-34 is/are allowed.
- 6) ☒ Claim(s) 16-20, 27, 28, 35, 36, 43 and 44 is/are rejected.
- 7) ☒ Claim(s) 21-28 and 37-44 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/461,402.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20040401, 20040706</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/461,402, filed on December 15, 1999. ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

3. Claims 21-28 and 37-44 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1, 5, 6, 10, 11, 15, 16, 20 and 29-36, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2624

5. Claims 16-20, 27, 28, 35, 36, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,798,845 (Baek et al.) in view of U.S. Patent 5,862,202 (Bashoura et al.).

Regarding claims 16, 17 and 27, Baek et al. disclose an image data communication apparatus connected to an image data source and a network, and transmitting image data to a receiving apparatus via the network, the image data communication apparatus comprising: a memory configured to store information regarding an identification of at least one user of the image data communication apparatus and a mail address of the at least one user (column 4, lines 36-43); a panel section configured to select the information regarding an identification of at least one user and the mail address of the at least one user stored in the memory (column 4, lines 26-35; column 4, line 59 – column 5, line 10); and a controller configured to set the information regarding the identification of the user selected by the panel section, into the mail message (column 5, lines 2-10). The image data source comprises a scanner connected to the image data communication apparatus (column 4, lines 7-9).

Baek et al. do not disclose a transmitter configured to transmit image data *attached to an e-mail, the e-mail including a mail from command and a mail message*. Bashoura et al. disclose a fax routing system capable of transmitting image data attached to an e-mail (column 4, line 66 – column 5, line 6). Note that Fig. 4 shows a table for storing e-mail addresses as well as telephone numbers and IP addresses of potential recipients of a fax message.

The fax routing system disclosed in Bashoura et al. enables a user to transmit image data via the Internet as well as through telephone lines as in a conventional fax transmission, thereby enabling reception at more destinations. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Baek et al. by providing a system for transmitting documents attached to e-mail, as disclosed in Bashoura et al.

Regarding claims 18 and 19, neither Baek et al. nor Bashoura et al. disclose a panel section comprising a *personal computer* connected to the image data communication apparatus, wherein the personal computer displays an HTML document for storing the information regarding the identification of the user and the mail address of the user in the memory. However, the concept of operating a fax machine, or other office machines such as printers and copiers, using operation keys from a personal computer is well known in the art for allowing tasks to be performed from a central location, thereby saving a user the trouble of having to go to a fax machine remotely located from his or her office. Therefore, it would have been obvious for one of ordinary skill in the art to modify the combined teachings of Baek et al. and Bashoura et al. by providing a personal computer for controlling the fax machine. As is known in the art, personal computers are capable of displaying HTML documents for storing information, in general.

Regarding claims 20 and 28, Bashoura et al. disclose converting image data attached to the e-mail into a format for e-mail transmission (column 4, lines 44-48; column 4, line 66 – column 5, line 3). As mentioned above, the fax routing system

Art Unit: 2624

disclosed in Bashoura et al. enables a user to transmit image data via the Internet as well as through telephone lines as in a conventional fax transmission, thereby enabling reception at more destinations. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Baek et al. by providing a system for transmitting documents attached to e-mail, as disclosed in Bashoura et al.

Claims 35, 36, 43 and 44 are method claims corresponding to above-rejected apparatus claims 16, 20, 27 and 28, respectively. The method steps are performed by the facsimile system disclosed in Baek et al. in view of Bashoura et al., as set forth above.

Allowable Subject Matter

6. Claims 1-15 and 29-34 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter: No prior art has been found to disclose or suggest "a controller configured to set the information regarding the identification of the user and the mail address of the user selected by the panel section, into the mail message of the e-mail to which the image data is attached, whereby opening, at the receiving apparatus, of the attached image data is not required to determine the information regarding the identification of the user, and the mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus," as recited in base claim 1 and similarly recited in base 29; or "a controller configured to set the information regarding the identification of the user and the mail address of the user selected by the panel section, into the mail message of the

Art Unit: 2624

e-mail to which the image data is attached, whereby opening, at the receiving apparatus, of the attached image data is not required to determine the information regarding the identification of the user, and a reply to the e-mail can be sent to the user without requiring input of the mail address of the user at the receiving apparatus, the reply being sent from the receiving apparatus," as recited in base claim 6 and similarly recited in base claim 31; or "a controller configured to set the information regarding the identification of the user and the mail address of the user selected by the panel section, into the mail message of the e-mail to which the image data is attached, whereby opening, at the receiving apparatus, of the attached image data is not required to determine the information regarding the identification of the user, and a reply to the e-mail is returned to the mail address of the user," as recited in base claim 11 and similarly recited in base claim 33.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl
November 26, 2004